

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1, 2 and 4-9 remain in the application of which claims 1, 2 and 4-7 are under active examination and directed to elected subject matter.

In the Official Action, items 1 and 2, applicants' prior traverse of the requirement for restriction has been noted. Claims 8 and 9 remain but identified as being "withdrawn" in the current response. Rejoinder of at least process claim 9 is authorized by MPEP §2116.01 implementing the Federal Circuit's decisions of *In re Ochiai*, 37 USPQ2d 1127 (1995) and *In re Brouwer*, 37 USPQ2d 1663 (1995):

If applicant elects claims directed to the product, and the product is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product will be rejoined. Where the restriction requirement is no longer applicable, the requirement (for restriction) should be withdrawn when the process claims are rejoined.

The claims have been amended in order to more particularly point out and distinctly claim that which applicants regard as their invention. More specifically, the subject matter of original claim 3, setting percentage ranges for the resin component and the conductive filler, are incorporated into claim 1. Thus claim 1 as amended requires the presence of from 50 to 80% by weight of the conductive filler calculated on the weight of the resin composition. The significance of this value is discussed below.

The Official Action contains two prior art-based rejections, the first directed to claims 1, 2 and 4-6 as allegedly being anticipated by Chacko U.S. 6,617,377. The remaining examined claims, 3 and 7, are rejected as being "obvious" over the disclosures of the same document.

In this amendment, the subject matter of claim 3 has been incorporated into claim 1 thus the rejection set out in item 4 of the Official Action is rendered moot. This leaves for consideration only the rejection in item 6, that of alleged "obviousness".

At the outset it must be recognized that the disclosure and intended audience for the applied reference is distinctly different from that of the present invention.

Chacko relates to a technology fundamentally different from the claimed invention in terms of "electrical conductivity", since Chacko is related to a "resistive composition" while the present applicants are concerned with – and specifically claim – **conductive** resin compositions.

A careful review of Chacko will reveal he discloses a resistive composition including 10-30 wt% of conductive particles; and 0.025-25 wt% of carbon nanoparticles (Abstract, etc.). With regard to more specific amounts, Chacko also discloses that the preferred content of the conductive particles is 1-10 wt% (column 5, lines 29-30) and that of the carbon nanoparticles is 0.1-7 wt% (column 4, line 63).

In the working examples of Chacko, the total amount of the conductive particles and the carbon nanoparticles at the highest amount is only a mere 18.94 wt% (i.e., a total amount of carbon black, carbon nanotubes and graphite) in Example 7, which has the largest amount of the conductive substance among the various examples, teaches away from the invention claimed in the amended claim 1, i.e., the range of the content of the conductive filler is a two-fold (or more) amount of 50-80 wt%. These relatively modest amounts are nevertheless consistent with Chacko's objectives in achieving resistive compositions. Therefore, the amended claim 1 would not have been obvious to one skilled in this art even in view of the teaching of Chacko.

For the above reasons it is respectfully submitted that claims 1, 2 and 4-7 (as well as possibly rejoined claims 8 and 9) define subject matter that is patentable over the disclosures of the applied reference. Reconsideration and favorable action are solicited. Should the examiner require further information, please contact the undersigned.

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